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Remarks

This Amendment is responsive to the **December 22, 2005** Office Action. Reexamination and reconsideration of claims 1-6, 8-14, 16-18, and 38-47 is respectfully requested.

Summary of The Office Action

Claims 19-35, and 37 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions. Election was made without traverse in the reply filed on 11/27/05.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Claims 1-2, 6, 8-14, 16, 18, 38-42 were rejected under 35 U.S.C. §102(a) as being anticipated by Benjamin et al. (US 6113208).

Claims 3-5, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Benjamin et al. as described in claim 1 above, and in view of Saldago et al. (US 20020067504).

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The Present Amendment

Claims 19-35 and 37 are being canceled as being directed to non-elected claims.

New claims 43-47 are presently added. Support for the language of claims 43-47 is disclosed in the present specification by, for example, the Summary page 3, lines 1-8, the specification page 12, lines 17-18, the specification page 18, lines 4-5, original claim 7, and/or Figure 4 block 412. Thus, no new matter has been added.

35 U.S.C. §112, first paragraph, Rejection

Claim 1 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the rejection states that the phrase "wherein the facilitating comprises downloading the software update from the component memory" is not described in the present specification.

Applicant respectfully submits that the phrase in question is supported by the present specification and that claim 1 complies with all requirements of 35 U.S.C. §112, first paragraph. For example, the phrase was taken from originally filed dependent claim 7 and thus is supported for this reason. Furthermore, the specification teaches that the software update itself can be stored on the cartridge memory in various embodiments and/or as part of the software update information. The present specification discloses, for example:

"In one implementation, the updated software to be provided to the user is simply stored in the cartridge memory." (Specification, page 3, lines 1-3).

"In one implementation, the software update information 336 is **the entire update...**" (Specification, page 12, lines 17-18) [emphasis added]

"At step 412, it is determined if the software update information 336 in the toner cartridge 322 is, **itself, the entire update.**" (Specification, page 18, lines 4-5) [emphasis added]

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Therefore, since the software update information 336 is stored in the memory on the cartridge and can be the entire update itself, then the update can be downloaded from the cartridge memory as claimed. Therefore, the claimed language is taught by the specification and claim 1 complies with all requirements of 35 U.S.C. §112, first paragraph. The rejection of claim 1 should thus be withdrawn.

The Claims Patentably Distinguish Over the References of Record

35 U.S.C. §102

For a 35 U.S.C. §102 reference to anticipate a claim, the reference must teach every element of the claim. Section 2133 of the MPEP recites:

> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent Claim 1

Claim 1 was rejected under 35 U.S.C. §102(a) as being anticipated by Benjamin et al. (US 6,113,208).

Claim 1 is directed to a method that recites facilitating a download of the software update utilizing the software update information from the component memory, wherein the facilitating comprises downloading the software update from the component memory. The reference does not teach or suggest downloading the software update from the component memory and thus fails to support the §102 rejection.

The Examiner stated that "the examiner interprets downloading software update from the vendor's website." (See Office Action page 3, lines 2-3). However, downloading the update from the component memory is a completely different process than downloading the update from a website. One of ordinary skill in the art understands these to be different. The

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present specification also describes them as two different implementations that involve different actions (see page 12, line 17 and page 13, lines 14-19). Therefore, the Examiner's interpretation is incorrect and thus incorrectly forms the basis of the rejection.

The Benjamin patent was cited as teaching claim 1 based on the interpretation of downloading software updates from a website. Claim 1 recites a different limitation of downloading the software update from the component memory and not from a website. Therefore, Benjamin fails to teach each and every limitation of claim 1. Thus, the rejection is not supported and must be withdrawn.

In particular, Benjamin fails to teach or suggest having the software update itself on its memory chip 20. Rather, Benjamin teaches that the memory chip 20 contains various parameters for providing a user with messages (see column 3, lines 30-49). Benjamin also discloses that a connection can be made to the manufacturer's Internet website to download an updated driver (column 4, lines 8-11). There is no teaching or suggestion that the updated driver itself is on the cartridge or its memory chip. Therefore, Benjamin fails to teach or suggest the claimed limitation of "downloading the software update from the component memory" as recited in claim 1.

Since claim 1 recites features not taught or suggested by the reference, claim 1 patentably distinguishes over the reference. Accordingly, dependent claims 1-6, 8-12, and 38-42 also patentably distinguish over the reference and are in condition for allowance.

<u>Independent Claim 13</u>

Claim 1 was rejected under 35 U.S.C. §102(a) as being anticipated by Benjamin et al. (US 6113208).

Claim 13 is directed to a printing device that comprises a replaceable component, a component memory integrated into the replaceable component, and software update information stored in the component memory. Claim 13 further recites that the software

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update information further includes the update available to be loaded for the printing device. Thus, the update itself is stored on the component memory.

As explained above and as confirmed by the Examiner, Benjamin discloses downloading a print driver from an website. Benjamin fails to teach or suggest having the update on the component memory. Therefore, Benjamin fails to teach or suggest each and every limitation of the claimed printing device and fails to support a proper §102 rejection. The rejection thus cannot stand and should be removed.

Since claim 13 recites features not taught or suggested by the reference, claim 13 patentably distinguishes over the reference. Accordingly, dependent claims 14, 15, 17, and 18 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 16

Claim 1 was rejected under 35 U.S.C. §102(a) as being anticipated by Benjamin et al.

Claim 16 is currently amended to clarify that the component memory integrated into the replaceable component includes a software update for the printing device. This limitation is disclosed in the present specification by, for example, page 3, lines 1-8, or page 12, lines 17-18, or page 18, lines 4-5. Thus, no new matter has been added.

As explained above, Benjamin fails to teach or suggest a printing device having component memory integrated into the replaceable component that includes a software update for the printing device. Rather, Benjamin discloses that a software update is downloaded from a remote website, and thus is not part of a component memory. For at least this reason, the rejection is not supported by Benjamin and thus the rejection must be withdrawn.

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Therefore, claim 16 patentably distinguishes over the references of record, individually or in combination with each other, and is now in condition for allowance.

Independent Claim 43

Newly added claim 43 patentably distinguishes over the references of record. Based on the previous explanations of Benjamin, Benjamin fails to teach or suggest a printing device as claimed. The other references of record also fail to teach or suggest the claimed printing device. Therefore, claim 43 and its dependent claims 44-47 patentably distinguish over the references of record and are in condition for allowance.

The §103 Rejections based on Benjamin in view of Salgado

The Salgado reference was cited for teaching features related to verification. Salgado, like Benjamin, discloses downloading software from a website and fails to teach or suggest any feature related to storing or downloading a software update from the component memory. Therefore, Salgado fails to cure the shortcomings of Benjamin and fails to form a proper §103 rejection against the present claims based on their respective claim language.

References Cited But Not Applied

The references cited but not applied have been considered and do not teach or suggest the recited features of the respective claims, individually or in combination with each other. Therefore, all claims are in condition for allowance.
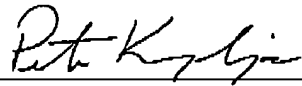
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Conclusion

For the reasons set forth above, **claims 1-6, 8-14, 16-18, and 38-47** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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